

The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

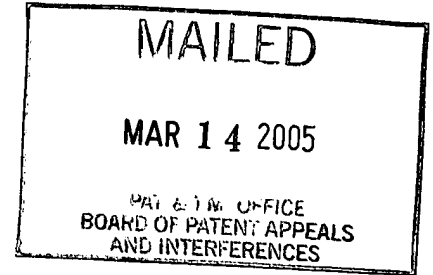
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHERYL HENRY

Appeal No. 2005-0321
Application No. 09/575,776

ON BRIEF



Before: BARRETT, GROSS, and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 8 and 10 through 22. For the reasons stated *infra* we reverse the examiner's rejection of these claims.

Invention

The invention relates to a device for ascertaining file directory information contained on a separable, portable, self-contained data storage device such as a floppy disk. See page 2 of appellant's specification.

Claim 1 is representative of the invention and reproduced below:

Claim 1

A portable apparatus for reading only file directory information stored on a separately portable self contained data storage device, the portable apparatus not in communication with a personal computer, the apparatus comprising:

a handheld housing;

a drive component for reading the file directory information on the data storage device;

a loading mechanism for receiving the data storage device and retaining the data storage device such that the drive component reads the directory file information on command;

a processor programmed to read and communicate only file information; and

a visual display operably connected to the drive component through the processor for viewing only the file directory information contained on the data storage device.

Reference

The reference relied upon by the examiner is:

Silverbrook

5,566,290

October 15, 1996

Rejection at Issue

Claims 1 through 8 and 10 through 22 stand rejected under 35 U.S.C. § 103 as being obvious over Silverbrook. Throughout the opinion we make reference to the brief and the answer for the respective details thereof.

Opinion

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellant and the examiner, and for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 8 and 10 through 22 under 35 U.S.C. § 103.

Appellant argues, on page 4 of the brief, that the rejection of claim 1 is improper as Silverbrook does not teach, "a visual display operably connected to the drive component through the processor for viewing only the file directory information contained on the data storage device." On pages 4 and 5 of the brief, appellant makes similar arguments directed to the "printer" of claim 6, the

information viewed through a display screen as claimed in claim 10, and "output device" of claim 13.

The examiner states, on page 7 of the answer, that the "device of Silverbrook ('290) is capable of reading, viewing or printing any file information including the file directory information (i.e. directory of the audio or video files). What Silverbrook did not disclose, is that the device is for processing the only [sic, only the] file directory information." Further, on page 7 of the answer, the examiner states the "claims of the instant application do not recite any software in support for the specific function (i.e. processing only the file directory information). Regarding the processor which is the main computer component, the claims only broadly state that the processor [is] programmed to read and communicate only file information, which any computer processor is designed to do." The examiner concludes, "[t]hus, [the] claims are silent regarding the specific way the processor is programmed in order to process only file directory information."

We concur with the examiner's assessment of Silverbrook's teachings, however, we disagree with the examiner's claim interpretation. We find that each of appellant's independent claims 1, 6, 10 and 13 is directed to a device (or method) that operates only with the file directory information. Claim 1 contains in the preamble the limitation "a portable apparatus for reading only file directory information," and we find that the preamble does further limit the claim as the remainder of the limitations in the claim, the drive component, the loading

mechanism, the processor and the visual display all refer to the file directory information. We find that independent claims 6, 10, and 13 contain similar limitations. While we recognize, as pointed out by the examiner, and acknowledged by the appellant¹ that there are some inconsistencies between how the file directory information is referred to in the different limitations of the claims (i.e. in claim 1, the loading mechanism limitation states: "the drive component reads the directory file information", and the processor limitation states "programmed to read and communicate only file information"), we nonetheless find it clear that the scope of the independent claims includes either displaying, printing, viewing or outputting, only with the file directory information. Nonetheless, the examiner and the appellant should insure that these inconsistencies are corrected in the application.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61

¹ Appellant states on page 2 of the brief that an amendment after final to rectify antecedent basis issues in the claims has been presented and a copy of the amended claims is also attached to the brief. The amended claims, in the May 7, 2003, after final amendment, do not contain the noted inconsistencies. However, the examiner states on page 2 of the answer that the amendment after final was not entered.

USPQ2d 1430, 1434 (Fed. Cir. 2002). In addition, our reviewing court stated in *In re Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433, that when making an obviousness rejection based on combination, “there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicant” (quoting *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)).

The examiner states on page 7 of the answer “[w]hat Silverbrook did not disclose, is that the device is for processing the only [sic, only the] file directory information.” We concur and find no disclosure in Silverbrook that teaches only displaying the file directory information. The examiner states, on page 5 of the answer, that “it would have been obvious ... to view any desirable information on said visual display, including only file directory information.” As stated supra independent claims 1, 6, 10 and 13 are directed to a device that operates only with file directory information. We find that Silverbrook teaches a system which permits editing of both audio and video data. (See abstract and column 1, lines 5-10). We find that modifying Silverbrook to only operate on the file directory information would not permit the device to perform editing of files. Thus, we do not find that Silverbrook provides any motivation, suggestion or teaching to modify the device as asserted by the examiner.

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